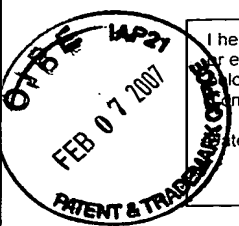


IAP13 Rec'd PCT/PTO 07 FEB 2007

PCT



I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: February 2, 2007

Signature:

*David A. Gass*  
(David A. Gass)

Docket No.: 19036/40796  
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:  
Yuka Matsui

Application No.: 10/561,629

Confirmation No.: 8420

Filed: June 21, 2004 as PCT/JP2004/008710 (national  
stage entry on December 20, 2005)

Art Unit: Not Yet Assigned

For: OPHTHALMIC COMPOSITION

Examiner: Not Yet Assigned

PETITION TO ACCEPT FILING UNDER 37 CFR §1.47(b)

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Assignee of the inventor's rights in the above-identified application hereby petitions the U.S. Patent and Trademark Office (the Patent Office) to accept the filing of the application under 37 CFR §1.47(b) by Assignee, Kobayashi Pharmaceutical Co., Ltd, without an executed inventor's declaration. This petition is necessary to preserve the rights of the assignee.

02/09/2007 MKAYPAGH 00000012 10561625

03 FC:1206

600.00 OP

Void date: 02/09/2007 JKURTZ1

02/09/2007 MKAYPAGH 00000012

03 FC:1206

10561629

-600.00 OP

02/09/2007 JKURTZ1 00000004 10561629

01 FC:1462

400.00 OP

02 FC:1463

200.00 OP

### **Introduction**

Rule 47(b) requires submission of: the oath/declaration; this petition, including proof of pertinent facts, showing that such action is necessary to preserve the rights of the assignee; the fee set forth in Rule 1.17(g); and the last known address of all inventors. As explained in greater detail below, all of these details have been filed herewith, except the address, which cannot be supplied without violating recently enacted Japanese privacy laws. Accordingly, in lieu of providing the inventors address, this petition is accompanied by a petition to suspend the rules to request acceptance of the application without the inventor's address. Favorable consideration of the petitions is requested.

### **Summary of materials filed with this petition**

Submitted herewith are the following documents:

(1) a response to the Notice to File Missing Parts (without inventor's signature on the declaration) (Appendix 1);

(2) an unexecuted inventor declaration naming, as sole inventor, Yuka Matsui, the individual believed by the Assignee to be the inventor of the subject matter claimed (Appendix 2);

(3) a copy of the Notice to file missing parts (Appendix 3);

(4) a petition for an extension of time of 5 months for responding to the Notice to file missing parts (Appendix 4);

(5) a Declaration of Facts For Petition to Accept Filing Under 37 CFR 1.47(b), executed by Madoka Yamashita, describing Assignee's diligent attempts to obtain inventor Matsui's signature on the declaration and her refusal to provide it (Appendix 5). This declaration includes its own Exhibits A-F;

(6) a copy of Japanese assignment executed by sole inventor Yuka Matsui for Japanese Patent Application No. 2003-176965, the Japanese application to which the above-identified application claims priority, as well as for applications claiming priority from said application (Exhibit A to the Yamashita declaration);

(7) an English translation of the Japanese assignment (Exhibit B to the Yamashita declaration);

(8) a petition to suspend the rules under 37 CFR §1.183 (Appendix 6);

(9) a declaration of facts signed by Mr. Tadato Fujiwara to support the petition to suspend the rules (Appendix 7);

(10) a signed statement under 37 C.F.R. 3.73(b) (Appendix 8); and,

(11) a check for \$2890.00 to cover the \$200 petition fee under 37 CFR §1.17(g) for the petition to accept filing under 37 CFR §1.47(b), the \$130 missing parts surcharge, the \$2160 five month extension of time fee, and the \$400 petition fee under 37 CFR §1.17(f) for the petition to suspend the rules under 37 CFR §1.183.

#### **Explanation of Facts in Support of this Petition**

The Patent and Trademark Office issued a Notice to File Missing Parts in this case on July 6, 2006. Accompanying this petition is a response to the Notice (Appendix 1), including an inventor's declaration (Appendix 2), a copy of the Notice (Appendix 3), petition for five months extension of time (Appendix 4), and fees. The inventor's declaration lacks the inventor's signature, necessitating this petition.

Kobayashi Pharmaceutical Co., Ltd., is the Assignee of all rights in the invention and patent application, as established by the assignment document and translation filed herewith (Exhibit C and D of Appendix 5) and recorded with the U.S. Patent and Trademark Office (Reel 018674, Frame 0470).

Madoka Yamashita, a Senior Staff member of Kobayashi Pharmaceutical Co., Ltd., has executed a Declaration of Facts (Appendix 4), concerning the Assignee's diligent efforts to obtain an executed inventor's declaration from Ms. Matsui. As explained in the Yamashita declaration, Ms. Matsui has been in possession of the Declaration form for the above-identified application since at least April 30, 2006, when a copy was hand delivered to her. (Yamashita Declaration paragraph 4.) Also, a copy of the declaration was sent to Ms. Matsui on April 28, 2006 via email (Yamashita declaration paragraph 4 and Exhibit D - copy

of the email). The Assignee contacted Ms. Matsui several times after that, including: by recorded mail on August 24, 2006, which she refused to receive (Yamashita Declaration paragraph 5 and Exhibit E -letter sent and recorded mail receipt and tracking summary); by email on August 29, 2006 (Yamashita Declaration paragraph 5 and Exhibit F - copy of email); and by telephone on August 30, 2006 (Yamashita Declaration paragraph 6.). In the telephone conversation of August 30, 2006 with Yasuyo Yamaguchi, a Manager of Kobayashi Pharmaceutical Co., Ltd., Ms. Matsui indicated that she would not sign any document relating to the above-identified application. (Id.)

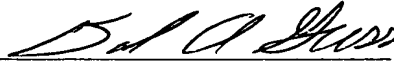
Because of Ms. Matsui's failure to sign the Declaration, and indications to the Assignee that she would not do so, the Assignee submits this petition is necessary to preserve Assignee's rights in the above-identified application.

Under Japanese law on protection of personal information, Ms. Matsui's personal address cannot be disclosed without her permission. Assignee requested Ms. Matsui's consent to provide her address information to support this petition and patent application, but she refused. Therefore, included with this petition is a petition to suspend the rules, under 37 CFR §1.183. A declaration of Mr. Tadato Fujiwara, a Japanese attorney, is filed in support of the petition to suspend the rules. Mr. Fujiwara explains the relevant Japanese law concerning provision of addresses of individuals, and its applicability to Assignee and the Assignee's current circumstances involving this patent application.

The Assignee respectfully requests that the Patent Office accept the filing of the above-identified application under 37 CFR §1.47(b) and 37 CFR §1.183. The U.S. Patent Office is authorized to charge any additional fees believed to be due to Deposit Account No. 13-2855, under Order No. 19036/40796.

Dated: February 2, 2007

Respectfully submitted,

By 

David A. Gass

Registration No.: 38,153

MARSHALL, GERSTEIN & BORUN LLP

233 S. Wacker Drive, Suite 6300

Sears Tower

Chicago, Illinois 60606-6357

(312) 474-6300

Attorney for Applicant

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: February 2, 2007

Signature: 

(David A. Gass)

Docket No.: 19036/40796  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Yuka Matsui

Application No.: 10/561,629

Confirmation No.: 8420

Filed: June 21, 2004 as PCT/JP2004/008710 (national stage entry on December 20, 2005)

Art Unit: Not Yet Assigned

For: OPHTHALMIC COMPOSITION

Examiner: Not Yet Assigned

**PETITION TO SUSPEND THE RULES UNDER 37 CFR §1.183**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Kobayashi Pharmaceutical Co., Ltd., the assignee of the inventor's rights in the above-identified patent application, hereby petitions the Patent and Trademark Office to waive the requirements under 37 CFR §1.47(b) to provide a mailing address for sole inventor, Yuka Matsui, on the basis that Assignee has been advised that, under the current circumstances, providing this information would violate Japanese law, namely, Japan's Act on the Protection of Personal Information.

**Background**

This petition accompanies a petition under Rule 1.47(b) in which the Assignee has requested that the above-identified application be accepted without the inventor's signature. The petition under Rule 1.47(b) is believed to be complete, except for the inventor's address. This petition is filed to request suspension of the rules and acceptance of the application without the inventor's address. The Patent Office is believed to have discretion to grant this petition within the framework of, e.g., 35 USC §118.

### Statement of Facts in Support of Petition


The Act on the Protection of Personal Information is a relatively new law in Japan, and it came into effect on May 30, 2003. However, the provision of the Act which effects Kobayashi Pharmaceutical and its ability to provide the inventor's address to the U.S. Patent Office came into force two years after this initial date, in 2005.

Attached to this petition is a declaration signed by Mr. Tadato Fujiwara, a registered attorney at law in Japan. Mr. Fujiwara explains in this declaration the requirements of this Act; he explains why Kobayashi Pharmaceutical is an entity that is bound by the Act; and he explains why the Act is interpreted by him, an attorney in Japan, to prohibit Kobayashi Pharmaceutical Co. from supplying an address for Ms. Matsui to the U.S. Patent and Trademark Office. Kobayashi Pharmaceutical Co., Ltd, cannot provide any personal information for an individual without that individual's consent. As stated in Mr. Fujiwara's declaration, Kobayashi attempted to acquire Ms. Matsui's consent to include her address, which she denied (see Declaration, Section 2 Facts, paragraph (5)). Thus, Kobayashi is barred from providing an address for Ms. Matsui under this Act.

Because the Assignee is a Japanese entity, it would be an apparent violation of Japanese law for the Assignee to provide the inventor's address to the U.S. Patent Office. In view of her refusal to consent to such disclosure, the Assignee respectfully requests the U.S. Patent Office suspend its rules and accept the above-identified application and petition under 37 CFR §1.47(b), without benefit of a last known address of Ms. Matsui.

Dated: February 2, 2007

Respectfully submitted,

By 

David A. Gass

Registration No.: 38,153

MARSHALL, GERSTEIN & BORUN LLP

233 S. Wacker Drive, Suite 6300

Sears Tower

Chicago, Illinois 60606-6357

(312) 474-6300


Attorney for Applicant



I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown above with sufficient postage as First Class Mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: February 2, 2007

Signature:

  
(David A. Gass)

Docket No.: 19036/40796  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Yuka Matsui

Application No.: 10/561,629

Confirmation No.: 8420

Filed: June 21, 2004 as PCT/JP2004/008710 (national  
stage entry on December 20, 2005)

Art Unit: Not Yet Assigned

For: OPHTHALMIC COMPOSITION

Examiner: Not Yet Assigned

**RESPONSE TO NOTICE TO FILE MISSING PARTS**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the Notice to File Missing Parts of Application – Filing Date  
Granted mailed July 6, 2006, Applicant respectfully submits a petition under 37 CFR  
§1.47(b), a petition under 37 CFR §1.183, an unexecuted Combined Declaration and Power  
of Attorney, a Petition for Extension of Time for 5 months, and Part 2 Copy of Notice.

The Assignee respectfully requests that the Patent Office accept the filing of  
the above-identified application under 37 CFR §1.47(b) and 37 CFR §1.183. The U.S. Patent  
Office is authorized to charge any additional fees believed to be due to Deposit Account No.  
13-2855, under Order No. 19036/40796.

Dated: February 2, 2007

Respectfully submitted,

By



David A. Gass

Registration No.: 38,153

MARSHALL, GERSTEIN & BORUN LLP  
233 S. Wacker Drive, Suite 6300  
Chicago, Illinois 60606-6357  
(312) 474-6300  
Attorney for Applicant





UNITED STATES PATENT AND TRADEMARK OFFICE

DECLARATION FOR PATENT APPLICATION

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am an original, first and sole inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled:

**OPHTHALMIC COMPOSITION**

the specification of which was filed on 21 June 2004 as PCT/JP2004/008710, and assigned U.S. Patent Application Serial No. 10/561,629

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by an amendment, if any, specifically referred to herein.

I acknowledge the duty to disclose all information known to me that is material to patentability in accordance with Title 37, Code of Federal Regulations, § 1.56.

**FOREIGN PRIORITY CLAIM**

I hereby claim foreign priority benefits under Title 35, United States Code § 119(a)-(d) of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

☐ no such foreign applications have been filed

☒ such foreign application have been filed as follows:

**EARLIEST FOREIGN APPLICATION(S), IF ANY FILED WITHIN 12 MONTHS  
(6 MONTHS FOR DESIGN) PRIOR TO THIS U.S. APPLICATION**

Application Number	Country	Date of Filing (dd/mm/yyyy)	Priority Claimed Under 35 USC 119
2003-176965	Japan	20/06/2003	<u>  x  </u> Yes No <u>    </u>

**ALL FOREIGN APPLICATION(S), IF ANY FILED MORE THAN 12 MONTHS  
(6 MONTHS FOR DESIGN) PRIOR TO THIS U.S. APPLICATION**

Application Number	Country	Date of Filing (dd/mm/yyyy)
None		

**CLAIM FOR BENEFIT OF EARLIER U.S. PROVISIONAL APPLICATIONS**

I hereby claim priority benefits under Title 35, United States Code §119(e), of any United States provisional patent application(s) listed below:

**CLAIM FOR BENEFIT OF EARLIER U.S./PCT APPLICATION(S)**

I hereby claim the benefit under Title 35, United States Code, §120 of the United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose all information that is material to patentability in accordance with Title 37, Code of Federal Regulations, §1.56 which became available to me between the filing date of the prior application and the national or PCT international filing date of this application:

☒ no such U.S./PCT applications have been filed.

☐ such U.S./PCT application have been filed as follows:

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

I hereby appoint:

All practitioners at Customer Number 04743

all of **MARSHALL, GERSTEIN & BORUN LLP**, 233 S. Wacker Drive, Suite 6300, Sears Tower, Chicago, Illinois 60606-6357, jointly, and each of them severally, my attorneys at law/patent agent(s), with full power of substitution, delegation and revocation, to prosecute this application, to make alterations and amendments therein, to receive the patent, and to transact all business in the U. S. Patent and Trademark Office connected therewith.

Please mail all correspondence to David A. Gass, whose address is:

**MARSHALL, GERSTEIN & BORUN LLP**  
233 S. Wacker Drive, Suite 6300  
Sears Tower  
Chicago, Illinois 60606-6357

Please direct telephone calls to: David A. Gass at (312) 474-6300.

Please direct facsimiles to: (312) 474-0448

Full name of sole or first inventor <b>Yuka Matsui</b>	
Sole or first inventor's signature	Date
Residence	
Citizenship <b>Japanese</b>	
Mailing Address  <b>Kobayashi Pharmaceutical Co., Ltd.. R&amp;D Company 30-3, Toyokawa 1-chome</b>	



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
10/561,629	Yuka Matsui	19036/40796

04743  
MARSHALL, GERSTEIN & BORUN LLP  
233 S. WACKER DRIVE, SUITE 6300  
SEARS TOWER  
CHICAGO, IL 60606

RECEIVED

JUL 13 2006

MARSHALL GERSTEIN

Docketed:

9/6/06

INTERNATIONAL APPLICATION NO.

PCT/JP04/08710

I.A. FILING DATE

06/21/2004

PRIORITY DATE

06/21/2003

CONFIRMATION NO. 8420

371 FORMALITIES LETTER



\*OC000000019497450\*

Date Mailed: 07/06/2006

### NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as a Designated / Elected Office (37 CFR 1.495).

- Copy of the International Application filed on 12/20/2005
- English Translation of the IA filed on 12/20/2005
- Copy of the International Search Report filed on 12/20/2005
- Information Disclosure Statements filed on 02/21/2006
- U.S. Basic National Fees filed on 12/20/2005
- Priority Documents filed on 12/20/2005

02/09/2007 MKAYPAGH 00000012 10561629

02 FC:1617

130.00 DP

The applicant needs to satisfy supplemental fees problems indicated below.

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date.
- To avoid abandonment, a surcharge (for late submission of filing fee, search fee, examination fee or oath or declaration) as set forth in 37 CFR 1.492(h) of \$130 for a non-small entity, must be submitted with the missing items identified in this letter.

#### SUMMARY OF FEES DUE:

Total additional fees required for this application is **\$130** for a Large Entity:

- **\$130** Surcharge.

ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE OR BY 32 MONTHS FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

*A copy of this notice **MUST** be returned with the response.*

CHARITTA A BURT

Telephone: (703) 308-9140 EXT 207

PART 1 - ATTORNEY/APPLICANT COPY


U.S. APPLICATION NUMBER NO.	INTERNATIONAL APPLICATION NO.	ATTY. DOCKET NO.
10/561,629	PCT/JP04/08710	19036/40796

FORM PCT/DO/EO/905 (371 Formalities Notice)

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: Feb 2, 2007

Signature:

  
(David A. Gass)Docket No.: 19036/40796  
(PATENT)**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**In re Patent Application of:  
Yuka Matsui

Application No.: 10/561,629

Confirmation No.: 8420

Filed: June 21, 2004 as PCT/JP2004/008710 (national  
stage entry on December 20, 2005)

Art Unit: Not Yet Assigned

For: OPHTHALMIC COMPOSITION

Examiner: Not Yet Assigned

**DECLARATION OF FACTS FOR PETITION TO ACCEPT FILING UNDER 37 CFR**  
**§1.47(b)**Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

I, Madoka Yamashita, hereby declare as follows:

1. I am a Senior Staff member of Kobayashi Pharmaceutical Co., Ltd., assignee of the above-identified application (hereafter "Assignee"). I submit this Declaration for the purpose of setting out facts relating to the refusal of Yuka Matsui, sole inventor of the subject matter in the above-identified patent application, to execute a Declaration.

2. On June 20, 2003, Japanese Patent Application No. 2003-176965 was filed, naming Ms. Matsui as sole inventor and naming Kobayashi Pharmaceutical Co., Ltd. as Applicant. On October 31, 2003, Ms. Matsui left Kobayashi Pharmaceutical. On June 21, 2004, PCT Application No. PCT/JP2004/008710 was filed, claiming priority to Japanese Patent Application No. 2003-176965. On December 20, 2005, U.S. national stage application of PCT Application No. PCT/JP2004/008710 was entered. The present application is that national stage application.

Application No. 10/561,629

Docket No.: 19036/40796

3. At the time of the invention, Ms. Matsui was an employee of the Assignee. Ms. Matsui executed an assignment (Exhibit A to this declaration) by which she assigned to the Assignee all of her rights in the invention, in the priority application No. 2003-176965, and in all related applications that claim such priority. A translation of the assignment is provided in Exhibit B.

4. On April 28, 2006, I emailed Ms. Matsui to provide her the unexecuted inventor's declaration ("the Declaration") for the above-identified application (Exhibit C). A copy of this email is attached as Exhibit D. I did not receive a response. On information and belief, two days later, Naoko Harada, a co-worker at Kobayashi Pharmaceutical Co., Ltd., hand-delivered the Declaration to Ms. Matsui.

5. I again sent the Declaration to Ms. Matsui via registered mail on August 24, 2006; however, she refused delivery. A copy of the letter sent and the receipt of the registered mail and tracking summary are attached as Exhibit E. On August 29, 2006, I sent the Declaration to Ms. Matsui via email, again with no response. A copy of this email is attached as Exhibit F.

6. On information and belief, my manager Yasuyo Yamaguchi called Ms. Matsui on August 30, 2006 to ask Ms. Matsui about the outstanding Declaration and she replied that she would not sign the Declaration.

7. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: December 7, 2006Signed: Madoka Yamashita

Name: Madoka Yamashita